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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/394,661 | 09/13/1999 | MASAAKI TSUJI | 2271/60220 | 4670 |

7590 06/05/2003

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| EXAMINER |
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RIMELL, SAMUEL G

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| ART UNIT | PAPER NUMBER |
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2175

DATE MAILED: 06/05/2003

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Please find below and/or-attached an Office communication concerning this application or proceeding.

PR-4

| | | | |
|------------------------------|-----------------|----------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/394,661 | TSUJI, MASAOKI | |
| | Examiner | Art Unit | |
| | Sam Rimell | 2175 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

[Signature]

**SAM RIMELL
PRIMARY EXAMINER**

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: The first paragraph calls for subcomponent data "which indicates any one of time information and information other than time information." The next two paragraphs of the claim indicate that the subcomponent data will in fact include both types of data (time data and non-time data). Thus, the quotation in the first paragraph contradicts the next two paragraphs of the claim, since the quotation in the first paragraph indicates that the two types data are optional and the next two paragraphs indicate they are both mandatory. In the last two lines of claim 1, the phrase "the outputs" lacks antecedent basis.

Claim 3: The first paragraph calls for subcomponent data "which indicates any one of time information and information other than time information." The next two paragraphs of the claim indicate that the subcomponent data will in fact include both types of data (time data and non-time data). Thus, the quotation in the first paragraph contradicts the next two paragraphs of the claim, since the quotation in the first paragraph indicates that the two types of data are optional and the next two paragraphs indicate that they are mandatory. In the fourth paragraph, the phrase "the outputs" lacks antecedent basis. The fifth and sixth paragraphs refer to "commands", whereas it is not clear whether these "commands" are the same as or different from the "first generating portions" or "second generating portion", which could also be viewed as software commands.

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~~Claim 4: The phrase "commands of the second commands" is vague and~~
~~incomprehensible.~~

Claim 5: Each of the three paragraphs of claim 5 include the phrase "the state of which", whereas it is not clear what structure or data actually has the alternating states referred to in the claim. In the third paragraph, the phrase "the output" lacks antecedent basis. In the last three lines, the phrase "based on a number of sectors based on original data of the subcode component data" is confusing and incomprehensible.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 5 is rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility.

The preamble of claim 5 states that the invention is directed to a subcode data generating circuit which generates subcode data including subcode components. However, the two claimed elements, a toggle generating portion and a selecting portion, do not appear capable of carrying out the function which is required by the preamble. Accordingly, the invention as claimed is inoperable, since the elements set forth in the claim cannot perform the function of generating subcode, as recited in the preamble.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawamura et al. (U.S. Patent 6,075,920).

Claim 1: FIG. 1 of Kawamura et al. discloses a control unit (20) which controls a first generating portion (9) which generates time code information, and control a second generating portion (schematically indicated by right arrow from control unit 20) that generates non-time-code information, such as sector number, copyright management information, track number, application ID number, application information and layer information. The first generating portion and second generating portion The time code information and non-time-code information are each components of subcode that are entered into a subcode generator (11) which outputs subcode. The control unit maintains controls over the output of the time code information and non-time-code information, and thus can be read as a selecting portion which selects output.

Claim 2: The second generating portion outputs six types of data, and can thus be said to comprise a plurality of generating portions.

Claim 3: See remarks for claim 1. Also note table of FIG. 6, which is a data table in memory having separate table locations (memory areas) for metadata (commands) associated with the time code data and non-time code data.

Claim 4: See claims 2-3.

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Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.

A handwritten signature in black ink, appearing to read 'S. Rimell', is positioned above the printed name.

Sam Rimell
Primary Examiner
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